

REMARKS/ARGUMENTS

Reconsideration of this case is respectfully requested.

The Examiner has pointed out that the specification does not include headings prescribed by 37 CFR 1.77(b). This amendment provides for the insertion of suitable headings throughout the specification.

Claim Objections

Claims 1, 16 and 28 are objected to because of certain formalities.

In claim 1, line 8, the language “thereby to removing” has been changed to “thereby removing.” In line 9 “expose” has been changed to “exposing.”

In claim 16, line 14, the language “utilising” has been changed to “utilizing.”

In claim 28, line 5 the language “for processing and/or display” has been changed to “for processing and/or displaying.”

Claim Rejections 35 U.S.C. § 112

Claims 1-3, 5-7, 8-15, and 22-28 are rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the Examiner has stated that there is insufficient antecedent basis for the limitation “the grinding grit” in line 8.

The amendment adds the limitation of a grinding wheel composing grinding grit to line 1 of claim 1 to provide antecedent basis for the recitation in line 8.

Claim 5, line 3 has been amended to recite an edge profile and a notch profile in a wafer in order to overcome the antecedent basis problems raised by the language “the edge profile” and “the notch profile.”

Claim 8, line 2 has been amended to recite a “circumferential edge of a forming wheel” to provide proper antecedent basis for the recitation of the circumferential edge in line 5 of claim 8.

In claim 13, the language “of the like” has been cancelled from line 4.

In claim 14 the word “otherwise” has been cancelled from line 3 and 4 so that the claim now recites “are measured and investigated to determine the correctness or lack of correctness of the ground profile.”

Double Patenting

Claims 1-34 have been rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,220,938 and claims 1, 6, 7 and 9 of U.S. Patent No. 6,428,397 B1. The Examiner states that the conflicting claims are not identical but are not patentably distinct from each other because the method claimed for conditioning the grinding wheel including the notch is similar to those claimed in U.S. Patents No. 6,220,938 and 6,428,397. Further, the Examiner states that although the patents do not claim the step of storing information derived from processing of the wafers and grindstone, that Ozaki in U.S. Patent, 5,185,965 discloses a method of grinding notches in semiconductor wafers in which information is stored for use as a guide in subsequent grinding procedures. The Examiner states it would have been obvious to one having ordinary skill in the art at the time the invention was made to have stored the processing information of U.S. Patent 6,220,938 and 6,428,397 as taught by Ozaki for use as a guide in subsequent grinding procedures.

The Examiner states that a timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome the rejection based on non-statutory double patenting provided that the conflicting application or patent is shown to be commonly owned with this application.

Included herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c). It is noted that both patents used in the double patenting rejection are assigned to UNOVA UK Ltd, and that the instant application is assigned to UNOVA UK Ltd. It is further noted that the terminal disclaimer is signed by the undersigned attorney Brian L. Ribando who is of record in this case pursuant to the Power of Attorney filed May 31, 2002.

The remaining references cited in this case have been reviewed with interest, but taken singly or in combination, do not appear to teach, disclose or render obvious applicant's invention as claimed.

For the foregoing reasons it is believed that this Amendment places the claims now appearing in this case in condition for allowance, and an early notice to such effect is respectfully solicited.

In the event that the Examiner does not agree that the claims are now in condition for allowance, he is courteously invited to contact the undersigned at the number given below in order to discuss any changes which the Examiner believes would lead to an allowance of the claims.

It is not believed that any fees other than the fee required in connection with the terminal disclaimer are necessitated by this amendment. However in the event that any

new fees or charges are required, authorization is hereby given to charge such fees to applicant's Deposit Account No 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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